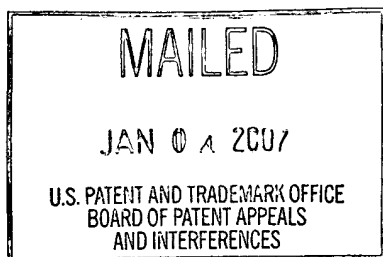


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

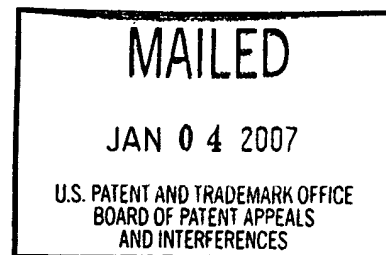
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GERALD R. KOEFELDA and DONALD L. BELL



Appeal No. 2006-2163
Application No. 09/710,516
Technology Center 3700



ON BRIEF

Before CRAWFORD, HORNER and FETTING, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-17, 19-21, 23-26, 29-41, and 43-48, all of the claims pending in the application. Claims 18, 22, 27, 28, and 42 have been canceled.¹

¹ The final office action, mailed August 6, 2004, included a rejection of then-pending claim 42. The appellants filed an Amendment After Final seeking to correct duplicate claims numbered 42 by canceling these claims and replacing them with claims 47 and 48. *See* Petition for Entry of Amendment After Final, dated December 23, 2004. The examiner entered this amendment in an

We affirm in part and enter new grounds of rejection of claims 9, 30, 31, 36, 38 and 43-46 pursuant to 37 C.F.R. § 41.50(b).

BACKGROUND

The appellants' invention relates to crate for holding a beverage container. Claim 1, reproduced below, is representative of the subject matter on appeal. A copy of all of the claims on appeal can be found in the appendix to the appellants' brief.

1. A crate for holding a beverage container having an outer surface with a lower portion and a central label area, the crate comprising:
 - a unitary bottom panel having an upper surface;
 - a first pair of opposed side walls and a second pair of opposed side walls attached to the periphery of the bottom panel to form a unitary construction therewith and defining a compartment area therein; and
 - a divider assembly having a plurality of divider members attached to the upper surface of the bottom panel and extending longitudinally and transversely in the compartment area to define at least one container receiving area for receiving the beverage container therein, the divider assembly including a plurality of low profile standoff portions having a container contact surface spaced from corresponding divider members and generally transverse to the upper surface of the bottom panel, the standoff portions extending inwardly

into the at least one container receiving area for engaging the lower portion of the container to provide stability thereto and for maintaining the corresponding beverage container in a spaced relationship from the divider members, wherein the standoff portions are shorter than the divider members and wherein the bottom panel, first and second pairs of opposed side walls and divider assembly are all integrally molded as one piece.

The examiner relies upon the following as evidence of unpatentability:

Sauey	2,928,530	Mar. 15, 1960
Hepp	5,335,814	Aug. 09, 1994
Apps	5,351,814	Oct. 04, 1994
Jamison	5,673,791	Oct. 07, 1997
Koefeldt	5,769,230	Jun. 23, 1998
Gale	5,975,300	Nov. 02, 1999

The following rejections are before us for review.

1. Claims 1-3, 5, 7-13, 15, 17, 19, 25, 26 and 29-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sauey.
2. Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sauey in view of Koefeldt.
3. Claims 4, 6, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sauey in view of Koefeldt and Apps.
4. Claims 1-3, 5, 7-13, 15, 17, 19, 25, 26, 29-41 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Apps in view of Sauey and Hepp.

5. Claims 1-5, 7-15, 17, 19, 20, 23-26, 29-41 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gale in view of Apps, Sauey and Hepp.
6. Claims 20, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Apps in view of Gale, Koefeldt, Sauey and Hepp.
7. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gale in view of Apps, Sauey, Hepp and Jamison, or over Apps in view of Gale, Koefeldt, Sauey, Hepp and Jamison.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the final office action (mailed August 6, 2004) and the examiner's answer (mailed February 3, 2006) for the examiner's complete reasoning in support of the rejection and to the appellants' brief (filed November 7, 2005)² and reply brief (filed April 3, 2006) for the appellants' arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification and claims, the applied prior art, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

² The appellants filed an Appeal Brief on February 9, 2005; however, the Board found the brief to be defective, returned the application to the examiner, and ordered the applicants to file a Supplemental Appeal Brief in compliance with 37 C.F.R. § 41.37. *See* Order Returning Undocketed Appeal to Examiner, mailed October 4, 2005. The appellants filed a Substitute Appeal Brief on November 7, 2005. We refer to this Substitute Appeal Brief throughout this opinion as the appellants' brief.

I. Rejection under 35 U.S.C. § 102(b)

The examiner rejected claims 1-3, 5, 7-13, 15, 17, 19, 25, 26 and 29-36 under 35 U.S.C. § 102(b) as being anticipated by Sauey. The appellants argue claims 1, 2, 5, 7, 8, 10, 11, 29-33 as a group. Brief, p. 10. Accordingly, we select claim 1 as the representative claim from this group. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2006). The appellants further argue claims 3, 12, 13, 15, 17, 19, 25, 26 and 34-36 as a group. Brief, p. 10. Accordingly, we select claim 12 as representative of the group. The appellants separately argue the patentability of claim 9, so we treat this claim separately.

In the examiner's rejection of these claims, the examiner determined that Sauey discloses a crate capable of holding a beverage container. The examiner found that the crate of Sauey has a unitary bottom panel, first and second pairs of opposing side walls and a divider assembly having longitudinal and transverse divider members and a plurality of low profile standoff portions. The examiner found that these standoff portions have container contact surfaces spaced from the corresponding dividers. Answer, p. 3.

With regard to claim 1, the appellants argued that the vertical protuberances (32) in Sauey are not "low profile" as claimed; rather, they contact a considerable length of the object. Brief, p. 10 and Reply, p. 3. The appellants point to page 11, lines 15-22 of their specification in support of the position that "low profile" is defined to mean that the height of the standoff portion is less than the corresponding bottle measurement for "the bottom of bottle to the bottom edge of label." Reply, p. 2.

We first construe the meaning of the phrase "low profile" as used by the appellants in the claims to describe the standoff portions. We determine the scope

of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (*en banc*) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

We remind appellants that it is their burden to precisely define the invention, not the PTO’s. *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

The phrase to be construed includes the word “low” which is inherently vague because its definition is relative in nature. The interpretation of this phrase

requires us to define the profile of the standoff portion in relation to another portion of the crate or container of the invention. We look to the specification to see how low profile is described. The only use of the phrase "low profile" in the specification is on page 11. We provide below the relevant section of the specification, beginning on page 10:

While standoff portions 50 may have any height feasible according to the teachings of the present invention, standoff portions 50 preferably have a relatively short height, such that they mate with and contact the container 38 at a bottom portion thereof, and below the label portion or the print portion typically disposed on a middle portion of the bottle or container, in keeping with the teachings according to the present invention. In the situation where the container is a glass or plastic bottle having a label (again either mounted or screened thereon), the standoff portion 50 mates with the glass or plastic portion of the container below the label. Each standoff portion 50 has a mating surface 51 for engaging the container 38. As illustrated in Figures 11-12, for container 38 having a cylindrical body portion, such mating surface 51 of standoff portion 50 is preferably contoured, having a curvature for mating with the container 38. While the height of the bottom edge of the standoff portion is contemplated to be dictated by the height of the corresponding bottle labeling (includes screening), it is noted that the height of standoff portion 50 is relatively short compared to the height of the divider members, the side walls, and the bottles themselves.

By way of example only and not limitation, a recent survey of twelve-ounce beverage bottles reflects the following bottle and label approximate measurements:

Bottle Number	Bottle Height	Bottom of Bottle to Bottom Edge of Label
1	9 inches	1 1/8 inches
2	9 1/2 inches	7/8 inch
3	9 1/8 inches	13/16 inch
4	7 5/8 inches	7/8 inch

Accordingly, the height of the standoff portions 50 for each bottle is preferably less than the corresponding bottle measurement for the "bottom of bottle to the bottom edge of label".

Again, standoff portions 50 keep the bottle from contacting the divider members and thus prevents rubbing against, peeling or other damage to the bottle label or to the other container markings. In keeping with the teachings of the present invention, standoff portion 50 should have a sufficiently *low profile* in order to achieve these same objectives. (Specification, page 10, line 23 – page 11, line 22) (emphasis added).

Based on this description in the specification, we understand the word "low" as a relative term comparing the height of the standoff portion to one of four parts of the claimed crate: (1) the height of the label or printing on the bottle; (2) the height of the divider members; (3) the height of the lower portion of the container, and (4) the height of the side walls. Further, because the specification states that "standoff portions 50 may have any height feasible according to the teachings of the present invention," we find that the claimed "low profile," in its broadest reasonable interpretation in light of the specification, requires only that the height of the standoff portion (50) be lower than one of: the height of the label area on the bottle, the height of the divider members, the height of the lower portion of the container, and the height of the side walls.

Based on this interpretation of claim 1, we find that Sauey anticipates the claimed invention, because the height of the protuberances (32) of Sauey are clearly shown as being below both the dividing members (18, 20) and below the side walls (22, 24) of the crate (10). Sauey, Figure 3. As such, Sauey discloses “low profile standoff portions” as claimed. As for the remaining elements of claim 1, we agree with the examiner’s findings as to where these elements are disclosed in Sauey, and the appellants have not contested any of the examiner’s findings in their briefs.

With regard to claim 12, the appellants argue that because Sauey teaches that the box contacts the shells along a considerable length of the shells, Sauey does not anticipate claim 12, which requires that the at least one standoff member does not contact the label of the container. We disagree with the appellants. Claim 12 recites, “at least one standoff member ... having a height relatively shorter than the divider members such that it is adapted to engage the lower portion of the container and oriented such that it does not contact the label of the container.” Sauey discloses a standoff member that has a height relatively shorter than the divider members such that it is “adapted to engage the lower portion of the container.” Sauey, Figure 3. Further, we find that the standoff portions of Sauey are capable of contacting the sides of a cylindrical member without contacting a label thereon. The limitation regarding the orientation of the standoff member relative to the label of the container depends upon where the label is placed on the container. If, for example, the box of Sauey were used to store bottles having a label only around the neck of the bottle, then the stand off portions (protuberances (32)) would engage the lower portion of the bottle and be oriented so that they would not contact the label on the neck of the bottle. As such, this claim

limitation, which is directed to the intended use of the standoff portions of the claimed crate, does not define a structural limitation of the claimed crate that would distinguish it from the protuberances used in the box of Sauey.

With regard to claim 9, the appellants argue Sauey does not anticipate this claimed invention because the protuberances (32) of Sauey are not “significantly shorter” than the dividing members. We find that Sauey discloses standoff portions that are shorter than the dividing members. For example, Sauey discloses that “the end portions 34 of the depressions 31 [which form protuberances 32] are spaced from the top edges 21 of the dividing walls.” Sauey, col. 2, lines 21-22. The question before us is whether Sauey discloses that height of the standoff portions is “significantly” shorter than the dividing members.

The appellants’ specification does not define what is meant by the term “significantly” in claim 9. The specification describes only that “the height of standoff portion 50 is *relatively short* compared to the height of the divider members.” Specification, page 11, lines 4-5 (emphasis added). As such, we find that one skilled in the art would not be able to understand from the specification what the modifier “significantly” adds to the requirement that the standoff portions are shorter than the divider members. As such, we sustain the examiner’s rejection of claim 9, and we enter a new ground of rejection of claim 9 as vague and indefinite under 35 U.S.C. § 112, second paragraph, because the appellants have failed to particularly point out and distinctly claim what the appellants regard as the invention. *See Ex parte Oetiker*, 23 USPQ2d 1641 (BPAI 1992) (holding claim reciting “substantial portion” to be indefinite because the specification lacked some standard for measuring the degree intended). We note that claims 30, 36 and 38 contain the same vague and indefinite recitation of “substantially shorter” as in

claim 9. Accordingly, we also enter the new ground of rejection against these claims and against claims 31 and 44-46, which depend from claim 30.

We also note that dependent claim 43 recites the limitation “wherein the divider members are at least several times taller than the standoff portions.” We fail to find support in the written description for this limitation. As we previously explained, the specification describes only that the standoff portions are “relatively shorter” than the divider members. As such, we enter a new ground of rejection of claim 43 under 35 U.S.C. § 112, first paragraph, for lack of an adequate written description of the invention.

In summary, we sustain the examiner’s rejection of claims 1-3, 5, 7-11, 13, 15, 17, 19, 25, 26, and 29-36 under 35 U.S.C. § 102(b), and we enter new grounds of rejection of claims 9, 30, 31, 36, 38 and 43-46 pursuant to 37 C.F.R. § 41.50(b).

II. Rejections under 35 U.S.C. § 103(a)

A. Sauey and Koefeld

The examiner rejected claims 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Sauey and Koefeld. The examiner relies on Koefeld for the teaching of a hinged lid having a lid capture area as claimed. Answer, p. 4. The appellants argue that there is no motivation to add the lid capture area of Koefeld to the box of Sauey because the shotgun shells are already completely separated from one another by the dividing walls (18, 20) and the vertical protuberances (32). Brief, p. 11. The appellants also argue that the shells would be spaced far enough from the cover (12) in Sauey that there would be no danger of damage to the shells from the cover (12).

To determine whether a prima facie case of obviousness has been established, we are guided by the factors set forth in *Graham v. John Deere Co.*,

383 U.S. 1, 17 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art.³

In addition to a review of the *Graham* factors, one must also consider whether there is a “teaching, suggestion, or motivation” to modify or combine the prior art teachings. This requirement was recently described in *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006):

[T]he “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness. (internal citations omitted).

“In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (citations omitted). In this case, the general problem to be solved was to develop a crate for storing and transporting containers

³ Although *Graham* also suggests analysis of secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., the appellant presented no such evidence of secondary considerations for the Board’s consideration.

where the crate is capable of stacking, where the containers are stable, upright, and do not tend to tilt, and where the container labels are protected.

To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”).

An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.

...

Precedent has also recognized that “[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art.”

In re Johnston, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (citing *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of

the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

With regard to the level of skill in the art, we find that a person of ordinary skill in the art would have been familiar with the prior art solutions to the problem facing the inventor. See *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (Holding that a person of ordinary skill in the art is presumed to know the relevant prior art, and to determine level of skill, the court may consider factors including: type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field). The prior art solutions included: (1) the use of separating projections on the lid of a crate to keep bottles stable and upright and to prevent damage to the tops of the bottles when the crates are stacked, as taught in Koefeldt (col. 2, lines 58-59 and col. 4, lines 53-59); (2) the use of separating protuberances to support cylindrical objects so that they remain in a vertical position within a box, as taught by Sauey (col. 1, lines 28-29 and col. 2, lines 36-40); and (3) the use of dividing walls to create compartments, as taught in both Sauey (col. 1, lines 60-68) and Koefeldt (col. 3, lines 65-66).

A person having ordinary skill in the art, facing the problem of creating a crate for holding and storing containers so that the crates are stackable and the containers remain upright and undamaged when stacked, would have been led to combine the crate having protuberances, as taught in Sauey, with the lid capture portions of Koefeldt. The crates in Sauey and Koefeldt both use divider members to create compartments for cylindrical containers. Koefeldt provides the

suggestion to store bottles in these compartments. If a person having ordinary skill in the art was designing a crate for use with bottles, as suggested by Koefeldal, he would have realized that additional support at the tops of the bottles, in the form of lid capture portions as taught by Koefeldal, would be needed in the box of Sauey to provide additional support and protection for the bottle tops. Because the bottles are as tall as the crate, as shown in Koefeldal, a person having ordinary skill in the art would realize that in order to stack the crates, a lid with lid capture portions would be preferable to protect the tops of the bottles and provide for better stacking of the crates. *See* Koefeldal, col. 3, lines 1-7. An implicit motivation would have existed, based on the teachings of the art and the nature of the problem facing the inventor, to combine these teachings. We, thus, find that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in Sauey and Koefeldal, would have been led to make the combination recited in the claims. As such, we sustain the rejection of claims 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Sauey and Koefeldal.

B. Sauey, Koefeldal and Apps

The examiner rejected claims 4, 6, 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Sauey in view of Koefeldal and Apps. The examiner relied on Apps to teach a lid with an outer surface with projections. Answer, p. 4.

With regard to claims 4 and 14, the appellants made the same argument that there would have been no motivation to modify Sauey to have a lid capture area. Brief, p. 11. For the same reasons provided *supra* in Section II.A., we do not find appellants' argument persuasive.

With regard to claims 6 and 16, the appellants argue that neither Sauey nor Apps show hinged lids. Brief, p. 11. This argument is unpersuasive because Koefeldt clearly shows a hinged lid (18) and the examiner is relying on the combined teachings of all three references for the finding of obviousness. As such, we sustain the examiner's rejection of claims 4, 6, 14, and 16 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sauey, Koefeldt and Apps.

C. Apps, Sauey and Hepp

The examiner rejected claims 1-3, 5, 7-13, 15, 17, 19, 25, 26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as obvious over Apps in view of Sauey and Hepp. With the exception of claims 47 and 48, the appellants argued the remainder of these claims as a group. As such, we treat claim 1 as the representative claim.

The examiner found that Apps discloses the invention of claim 1 except for the standoffs having a container contact surface generally transverse to the upper surface of the bottom panel. The examiner relied on Sauey and Hepp to disclose standoffs which are generally transverse to the upper surface of the bottom panel. Answer, p. 5. The examiner found that it would have been obvious to replace the standoffs of Apps or add additional standoffs as taught by Sauey and Hepp to provide a more effective securement or to further secure the position of the items stored in the crate. Answer, p. 5.

The appellants argue that because the divider walls in Apps are shown in contact with the bottles, there would be no motivation to add standoff portions to provide more effective securement. Brief, pp. 12-13. We agree with the appellants. Although Apps recognizes the problem of damage caused to labels from the bottles rubbing against the crate or other bottles, it solves the problem

using dividing wall (216), separator rings (260) and receiving caps (262) to maintain the bottles (106, 108) in an upright and spaced condition. Apps, col. 8, lines 55-85. Because the bottles in Apps are shown in immediate contact with the dividing walls, we see no motivation to add standoff portions to remove the bottles from the dividing walls absent hindsight from the appellants' own disclosure. Because we disagree with the examiner's combination of the references, we find no need to address the remaining arguments raised by the appellants with regard to this rejection. Accordingly, we do not sustain the rejection of claims 1-3, 5, 7-13, 15, 17, 19, 25, 26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as obvious over Apps in view of Sauey and Hepp.

D. Gale, Apps, Sauey and Hepp

The examiner rejected claims 1-5, 7-15, 17, 19, 20, 23-26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as unpatentable over Gale in view of Apps, Sauey and Hepp. The examiner found that Gale discloses a crate for holding a beverage container having, *inter alia*, a divider assembly with a plurality of divider members formed by portions of the upper surface of inserts 81 and 82 located outside of and extending between the major wells (91) and the upwardly extending sidewall portions of the wells. Answer, p. 5 The examiner further found that the divider assembly includes a plurality of low profile standoff portions (cylindrical rib (96)) having a container contact surface spaced from corresponding divider members. Answer, p. 6.

The appellants argue that Gale does not disclose "standoff portions" that maintain the beverage container in a spaced relationship from the portion of the inserts that the examiner has found to be the divider members. Rather, the

appellants argue that the beverage container in Gale appears to be in direct contact with these divider members. We agree.

Gale recognizes the problem of scuffing of bottle labels caused by shipping containers that use vertical partitions. The solution proposed by Gale is to eliminate the use of vertical partitions within the carton and use instead inserts that engage the bases of the bottles and the necks of the bottles to maintain spacing between the bottles. Gale, col. 1, lines 9-32. As such, Gale has no disclosure of a standoff portion, as claimed, that maintains the beverage container in a spaced relationship from the divider members, because Gale has eliminated the divider members entirely.

Even if we accept the examiner's findings that the cylindrical rib (96) of Gale is a standoff portion and the upper surface of inserts (81, 82) extending between the major wells (91) are dividers, Gale still does not meet the claim language because the cylindrical ribs (96) do not maintain the bottles spaced from the upper surface of the inserts. Rather, Gale describes that the cylindrical ribs (96) provide a cylindrical recess (97) that is sized to receive the neck or top (79) of a bottle (77) so that cartons can be used to ship bottles upside down, i.e., neck down. In that instance, the neck of the bottle would not touch the sides of the major wells (91), however, the claims require that the standoff portions (cylindrical ribs (96)) engage the lower portion of the container. When the carton of Gale is used to hold bottles upside down, the cylindrical ribs are not acting as standoff portions because they are not capable of engaging the lower portion of the bottle.

Further, we find no motivation to combine the teachings of Gale with the remaining references, because the purpose of Gale is to eliminate conventional divider members. As such, a person having ordinary skill in the art at the time the

invention was made would not have modified the carton of Gale to add the conventional divider members. Accordingly, we do not sustain the examiner's rejection of claims 1-5, 7-15, 17, 19, 20, 23-26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as unpatentable over Gale in view of Apps, Sauey and Hepp.

E. Apps, Gale, Koefeld, Sauey and Hepp

The examiner rejected claims 20, 23 and 24 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Apps, Gale, Koefeld, Sauey and Hepp. The appellants argue these claims as a group. Brief, pp. 15-16. As such, we select claim 20 as the representative claim.

The examiner found that Apps discloses the claimed invention except for the hinged lid and that Gale and Koefeld teach hinged lids. The examiner found that it would have been obvious to add a hinge to the lid to keep the lid attached so that it doesn't become separated from the crate. Answer, p. 7. The examiner relied on Sauey to teach standoff portions that are generally transverse to the upper surface of the bottom panel and that are substantially shorter than the dividers. The examiner found that it would have been obvious to add the standoff portions of Sauey to the crate of Apps to provide a more effective securement or to further secure the position of the items stored in the crate. Answer, p. 7.

The appellants relied on their arguments with regard to the rejection of Apps in view of Sauey and Hepp to overcome this rejection. Brief, pp. 15-16. As set forth *supra* in Section II.C., we do not find sufficient motivation to combine the teachings of Apps and Sauey that would have led one having ordinary skill in the art to the container as claimed. As such, for this same reason, we do not sustain the examiner's rejection of claims 20, 23, and 24 under 35 U.S.C. § 103(a) based on the combined teachings of Apps, Gale, Koefeld, Sauey and Hepp.

F. Apps, Gale, Koefeld, Sauey, Hepp, Jamison

The examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Apps, Gale, Koefeld, Sauey, Hepp and Jamison or Gale, Apps, Sauey, Hepp and Jamison. The examiner relied on Jamison for the teaching of a lid lock. The examiner found that it would have been obvious to lock the lid to prevent unauthorized access to the contents of the crate. Answer, p. 8. The appellants relied on their arguments for the patentability of claim 20, from which claim 21 depends. Brief, p. 16. As set forth *supra* in Sections II.C. and II.E., we do not find sufficient motivation to combine the teachings of Apps and Sauey or sufficient motivation to combine the teachings of Gale with the remaining references that would have led one having ordinary skill in the art to the crate as claimed. As such, for these same reasons, we do not sustain the examiner's rejection of claim 21 under 35 U.S.C. § 103(a).

CONCLUSION

To summarize:

- 1) We sustain the rejection of claims 1-3, 7-11, 13, 15, 17, 19, 25, 26 and 29-36 under 35 U.S.C. § 102(b) as being anticipated by Sauey.
- 2) We sustain the rejections of claims 4 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Sauey in view of Koefeld.
- 3) We sustain the rejections of claims 4, 6, 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Sauey in view of Koefeld and Apps.
- 4) We do not sustain the rejection of claims 1-3, 5, 7-13, 15, 17, 19, 25, 26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Apps in view of Sauey and Hepp.

- 5) We do not sustain the rejection of claims 1-5, 7-15, 17, 19, 20, 23-26, 29-41 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Gale in view of Apps, Sauey and Hepp.
- 6) We do not sustain the rejection of claims 20, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Apps in view of Gale, Koefeld, Sauey and Hepp.
- 7) We do not sustain the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Apps in view of Gale, Koefeld, Sauey, Hepp and Jamison.
- 8) We do not sustain the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Gale in view of Apps, Sauey, Hepp and Jamison.
- 9) We enter a new ground of rejection of claims 9, 30, 31, 36, 38, and 44-46 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim what the appellants regard as the invention.
- 10) We enter a new ground of rejection of claim 43 under 35 U.S.C. § 112, first paragraph, for lack of an adequate written description of the invention.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004). 37 C.F.R. § 41.50(b) provides, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

AFFIRMED IN PART; 37 C.F.R. § 41.50(b)

ANTON W. FETTING
Administrative Patent Judge

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